IN THE DRAWINGS

FIG. 1 has been amended to show labels for references 112-118 as shown in the attached Replacement Sheet.

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REMARKS

Applicant thanks the Examiner for conducting a telephone interview to discuss the pending issues as stated in the Office Action. The points of discussion during the interview are included within the following remarks.

The drawings stand objected to because there are no labels for references 112-118 in FIG. 1. Applicant has amended FIG. 1 by adding labels for each of the references 112-118. A replacement sheet of drawings that includes FIG. 1 is attached in compliance with 37 CFR 1.121(d). Reconsideration and withdrawal of the objection is respectfully requested.

Claims 1, 5 and 6 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,036,310 issued to Russell. Applicant has amended claim 1 to include the limitations of claims 2 and 3, which were not rejected as being anticipated by Russell. Claim 1 has been amended to be identical to original claim 3.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Since the Examiner determined that claims 2 and 3 were not anticipated by Russell, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 as now amended. Applicant further requests reconsideration and withdrawal of dependent claim 5, which depends from claim 1.

Claims 1-3, 5-9 and 11-15 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,307,472 issued to Robertson. Robertson discloses a networked architecture of mailboxes for indicating when the mailboxes are in use or occupied with mail. (Robertson, col. 2, lines 19-25). Sensors are placed in the mailboxes to determine when mail is placed in the box and such sensors include motion sensors, mass sensors and weight sensors. (Robertson, col. 2, lines 43-

61). The sensors are coupled to an indicator apparatus in signal communication. (Robertson, col. 2, lines 39-41). When the sensor is moved to the active condition indicating occupancy, the sensor sends a signal to the indicator apparatus that then emits a stimulus to indicate usage or occupancy of the mailbox. (Robertson, col. 3, lines 30-37). The stimulus emitted by the indicator apparatus may be audio or visual and may comprise a light fixture, a video display device or other type of device operative for emitting visual stimulus or a speaker or other device operative for emitting an audible stimulus. (Robertson, col. 3, lines 15-24). A protocol is also disclosed by Robertson that defines processing, communication, computing, logic circuitry and/or controller apparatus for providing communication between the mailbox and the indicator apparatus. (Robertson, col. 3, lines 38-42). The protocol comprises means for controlling the signal sent by the sensor as being addressed to a particular element of the indicator apparatus or to a particular element of single indicator apparatus. (Robertson, col. 3, lines 43-51). If the indicator comprises a computer, a pager or a telephone, the user may dial into the protocol to access data regarding the mailbox occupancy. *Id.*

Applicant claims a method, computer program product and an apparatus that includes, *inter alia*, detecting a weight of at least one piece of mail in the mailbox, *determining whether* to send a notification to the address based on the weight information and transmitting an electronic notification to the address indicating the presence of the at least one piece of mail in the mailbox. (Amended claims 1, 7 and 12). Claims 1 and 12 were amended to include all the limitations of claims 3 and 14 and any intervening claims so that amended claims 1 and 12 are identical in scope to original claims 3 and 14.

MPEP § 2131 provides:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.,* identity of terminology is not required. *In re Bond,* 910 F.2d 831 (Fed. Cir. 1990).

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Applicant respectfully asserts that a prima facie case of anticipation has not been presented because each element set forth in Applicant's claims cannot be found, either expressly or inherently described in the cited prior art reference. In particular, Roberson fails to disclose that the mailbox system described therein includes any step of means for *determining whether* to send a notification based on the weight information. Robertson merely discloses that if the sensor, be it a weight sensor, motion sensor or any of the many sensors disclosed by Robertson, senses a presence, a signal is triggered to indicate occupancy of the mailbox.

Differently, Applicant discloses that a user may enter preferences into a database, for example, to be notified that the mailbox is in use only if the weight reaches a certain weight, e.g., five ounces. (Specification, p. 9, lines 3-6). Therefore, Applicant claims a method, computer program product and apparatus that particularly claims *determining whether* to send notification based on the weight information. Such a limitation is not disclosed by Robertson.

Therefore, since Robertson does not disclose each and every limitation claimed by Applicant, Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented. Applicant respectfully requests reconsideration and withdrawal of the rejection of original claims 3 and 14. Applicant further requests reconsideration and withdrawal of the rejection of amended independent claims 1, 7 and 12, which have been amended to include the limitation of claims 3 and 14, *i.e.*, *determining whether* to send notification based on the weight information. Applicant further requests reconsideration and withdrawal of the rejection of all claims depending from independent claims 1, 7 and 12.
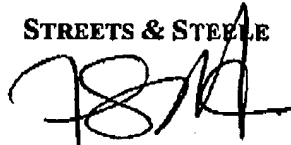
Claims 4 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,307,472 issued to Robertson in view of U.S. Patent No. 4,872,210 issued to Beneges. For the reasons provided in the remarks above concerning independent claims 1 and 7, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 4 and 10, which depend from independent claims 1 and 7, respectfully.

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Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests that a Notice of Allowance be issued. If the Examiner determines that a telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM-0039 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,

STREETS & STEELE

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